

DRAWING AMENDMENTS

The drawings have been amended to include Figures 1A and 3A. The amended drawing sheets are attached, and were amended to show the different surface portions of Claim 38 and the multiple fibers of Claim 44. Since these features were previously claimed and described in the specification, the amendments do not constitute the addition of new matter.

REMARKS (37 CFR 1.111)

Applicant has considered all points made by the Examiner in the Office Action and has incorporated Examiner's suggestions to ensure compliance with the applicable rules.

Applicant amended the claims to clarify the structure which the Applicant believes distinguishes the present invention over the cited references, to clarify the function of the claimed invention, and to clarify the limitations within the claims drawn to such a structure. However, such amendments have not been made to narrow the claims of the original application, but rather simply to clarify claims due to grammar that the Examiner found unclear. Applicant believes the amended claims are supported by the specification.

Double Patenting and Terminal Disclaimer

The Examiner has rejected Claims 35, 37-41, 45, 47, 48, and 50 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 14-19 of U.S. Patent No. 6,607,486. The Examiner has acknowledged that the claims are not identical, but asserts that they are not patently distinct from each other. The Examiner has further acknowledged that a terminal disclaimer will overcome these rejections. Therefore, in conjunction with this Response, Applicant has filed a terminal disclaimer pursuant to 37 CFR 3.73(b).

Note: The office action recites that Claim 49 stands rejected for double patent as well. However, the office action also states that Claim 49 defines over the prior art. In a telephone conference on or about August 16, 2004, the Examiner clarified to Applicant's attorney that Claim 49 is allowable as it stands and that it should not have been included in the list of claims

rejected for double patenting. For this reason, Applicant has not addressed Claim 49 in the above.

The Examiner has rejected Claims 36, 42, 43, and 46 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 14-19 of U.S. Patent No. 6,607,486 in view of Rawson, U.S. Patent No. 5,436,444. (Note: Also in the August 16, 2004, telephone conversation, the Examiner clarified that Claim 46 was not, but should have been included in this group claims rejected for double patenting in view of Rawson, therefore Applicant is addressing Claim 46 as well.) Applicant disagrees that such claims are obvious in light of Rawson. The Rawson disclosure is unrelated to Applicant's disclosure and claims. Applicant's claimed invention is directed to a device that generates an output signal in response to labor contractions, which involve relatively small movements of the female abdomen. Rawson, by contrast, is directed to a device for generating audible sound in response to relatively large, gross movements of a person or object, such as stepping on a game pad (see col. 2, lines 4-19), rolling over (see col. 4, lines 58-60), or walking about in a toy suit of "armor" (see col. 6, lines 24-38). Rawson does not teach, disclose, or suggest a device that generates an output signal in response to labor contractions. More specifically, contrary to the Examiner's assertion in the Office Action, Rawson does not teach or suggest that any appropriate means, including adhesive, may be used to attach the sensor to the patient. Rather, Rawson teaches only mechanical attachment of the sensor to the patient (see col. 3, lines 55-57). The discussion in Rawson of adhesive or other means of attachment is for the attachment of the fiber 18 to the sensor carrier 21 (see col. 3, line 51 through col. 4, line 4), not the attachment of the sensor to the patient. Similarly, Rawson does not disclose a pouch in which the sensor may be disposed. Therefore, Rawson does not anticipate or render obvious any of Applicant's claims.

Additionally, in conjunction with this Response, Applicant has filed a terminal disclaimer pursuant to 37 CFR 3.73(b).

Drawing Objections

The Examiner has objected to the drawings pursuant to 37 C.F.R. 1.83(a) claiming that they do not show every feature of the invention specified in the claims. Specifically, the Examiner claims that the different surface portions of Claim 38 and the multiple fibers of Claim 44 were not shown. The drawings have been amended to include these features and have been submitted herewith. Since these features were previously claimed and described in the specification, the amendments do not constitute the addition of new matter.

35 U.S.C. § 102 Rejection

Claims 35, 40-43, 45, 47, 48, and 50 were rejected under 35 U.S.C. § 102(e) as being anticipated by Rawson. Anticipation is a factual determination. In order to establish anticipation, it is incumbent upon the Examiner to identify in a single prior art reference disclosure of each and every element of the claims in issue, arranged as in the claim. *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458, 221 U.S.P.Q. 481 (Fed. Cir. 1984); *In re Schaumann*, 572 F.2d 312, 197 U.S.P.Q. 5 (C.C.P.A. 1978) (anticipation is measured with respect to the terms of the claims in issue).

Note: The office action recites that Claim 49 stands rejected under 35 U.S.C. § 102(e) as well. However, the office action also states that Claim 49 defines over the prior art. In a telephone conference on or about August 16, 2004, the Examiner clarified to Applicant's attorney that Claim 49 is allowable as it stands and that it should not have been included in the

list of claims rejected under 35 U.S.C. § 102(e). For this reason, Applicant has not addressed Claim 49 in the above.

When determining if a prior art reference anticipates a claim containing elements expressed as a means for performing a function pursuant to 35 U.S.C. § 112, last paragraph, "the limitations which must be met are those set forth in each statement of function." *RCA Corp. v. Applied Digital Data Sys., Inc.*, 730 F.2d 1440, 1445 n.5, 221 U.S.P.Q. 385, 389 (Fed. Cir. 1984).

When the claimed invention is not identically disclosed in a reference, and instead requires picking and choosing among a number of different options disclosed by the reference, the reference does not anticipate. *Akzo N.V. v. U.S. Int'l Trade Comm'n*, 808 F.2d 1471, 1480, 1 U.S.P.Q.2d 1241, 1245-46 (Fed. Cir. 1986), cert. denied, 482 U.S. 909, 107 S.Ct. 2490 (1987).

Applicant respectfully traverses the rejection of Claims 35, 40-43, 45, 47, 48, and 50. As set forth above, the Rawson disclosure is unrelated to Applicant's disclosure and claims. Applicant's claimed invention is directed to a device that generates an output signal in response to labor contractions, which involve relatively small movements of the female abdomen. Rawson, by contrast, is directed to a device for generating audible sound in response to relatively large, gross movements of a person or object, such as stepping on a game pad (see col. 2, lines 4-19), rolling over (see col. 4, lines 58-60), or walking about in a toy suit of "armor" (see col. 6, lines 24-38).

In conjunction with the above, Rawson does not disclose each of the elements of Claim 35. Without limitation, Claim 35 includes a limitation that the sensing device be "adaptable for conforming the sensor to the contour of the abdomen of a pregnant female." Rawson makes no mention of such characteristic. Additionally, Rawson only provides for reproducing signals as

sound. In contrast, Claim 35 requires that the output signal be communicated for monitoring labor contractions. Applicant disagrees that Rawson discloses an “optical strain guage” or “fiber optic strain sensor” as claimed in Claim 35 capable of generating an output signal in response to a labor contraction, and disagrees that this is simply an intended use. Rather, the requirement that the sensor be capable of generating an output signal in response to a labor contraction requires a degree of sensitivity that the movement sensor in Rawson does not disclose.

Rawson does not anticipate Claim 40 in that it is dependant upon Claim 35 and since all elements of the independent Claim are not disclosed, likewise, Rawson does not disclose all of the elements, and the combination of elements, of the dependent Claim.

Rawson does not anticipate Claim 41 in that it is dependant upon Claim 35 and since all elements of the independent Claim are not disclosed, likewise, Rawson does not disclose all of the elements, and the combination of elements, of the dependent Claim. Additionally, the Examiner has indicated that this claim would be allowable if the Applicant were to specify that “the drape overlies the sensor pad in use.” However, Claim 41 already specifies that the drape is “overlying said sensor.” The only apparent difference is the “in use” language, which seems inconsequential given that “in use” is inherrent in using the device. Therefore, Applicant believes that this claim is allowable without amendment.

Rawson does not anticipate Claim 42 in that it is dependant upon Claim 35 and since all elements of the independent Claim are not disclosed, likewise, Rawson does not disclose all of the elements, and the combination of elements, of the dependent Claim. Additionally, again without limitation, Claim 42 provides for wireless communication which is not disclosed in Rawson. Rawson does disclose radio transmission, which is one type of wireless, but it does not disclose the other possibilites that are in Claim 42.

Rawson does not anticipate Claim 43 in that it is dependant upon Claim 35 and since all elements of the independent Claim are not disclosed, likewise, Rawson does not disclose all of the elements, and the combination of elements, of the dependent Claim.

Rawson does not disclose each of the elements of Claim 45. Without limitation, Claim 45 includes a limitation that the sensing device be “adaptable for conforming the sensor to the contour of the abdomen of a pregnant female.” Rawson makes no mention of such characteristic. Additionally, Rawson only provides for reproducing signals as sound. In contrast, Claim 45 requires that the output signal be communicated for monitoring labor contractions. Applicant disagrees that Rawson discloses an “optical strain guage” or “fiber optic strain sensor” as claimed in Claim 45 capable of generating an output signal in response to a labor contraction, and disagrees that this is simply an intended use. Rather, the requirement that the sensor be capable of generating an output signal in response to a labor contraction requires a degree of sensitivity that the movement sensor in Rawson does not disclose. Additionally, the Examiner has indicated that this claim would be allowable if the Applicant were to specify that “the drape overlies the sensor pad in use.” However, Claim 45 already specifies that the drape is “overlying said sensor.” The only apparent difference is the “in use” language, which seems inconsequential given that “in use” is inherrent in using the device. Therefore, Applicant believes that this claim is allowable without amendment.

Rawson does not disclose each of the elements of Claim 47. Without limitation, Claim 47 includes a limitation that the adhesive pad be “conformable to the contour of the abdomen of a pregnant female.” Rawson makes no mention of such characteristic. Additionally, Rawson only provides for reproducing signals as sound. In contrast, Claim 45 requires that the output signal be communicated for monitoring labor contractions. Applicant disagrees that Rawson

discloses a device capable of generating an output signal “representative of the labor contraction,” and disagrees that this is simply an intended use. Rather, the requirement that the sensor be capable of generating an output signal in response to a labor contraction requires a degree of sensitivity that the movement sensor in Rawson does not disclose.

Rawson does not anticipate Claim 48 in that it is dependant upon Claim 47 and since all elements of the independent Claim are not disclosed, likewise, Rawson does not disclose all of the elements, and the combination of elements, of the dependent Claim.

The Examiner has listed Claim 50 as being rejected under §102(e), however later in the office action the Examiner indicates that it would be allowable if amended to include all limitations of the base claim and any intervening claim(s) (and if the double patenting rejection was overcome). While Applicant agrees that Claim 50 is allowable if rewritten in independent form as indicated, Applicant disagrees that it is not allowable as written (the double patenting rejection being otherwise addressed). Rawson does not anticipate Claim 50 in that it is dependant upon Claim 47 and since all elements of the independent Claim are not disclosed, likewise, Rawson does not disclose all of the elements, and the combination of elements, of the dependent Claim.

Thus, the patent cited by the Examiner does not disclose each and every element of the claims at issue.

35 U.S.C. § 103(a) Rejections

Pursuant to 35 U.S.C. §103(a), the Examiner has rejected Claim 36 on the basis that said claim is unpatentable over Rawson. As set forth above, the Rawson disclosure is unrelated to Applicant’s disclosure and claims. Contrary to the Examiner’s assertion in the Office Action, Rawson does not teach or suggest that any appropriate means, including adhesive, may be used

to attach the sensor to the patient. Rather, Rawson teaches only mechanical attachment of the sensor to the patient (see col. 3, lines 55-57). The discussion in Rawson of adhesive or other means of attachment is for the attachment of the fiber 18 to the sensor carrier 21 (see col. 3, line 51 through col. 4, line 4), not the attachment of the sensor to the patient. Similarly, Rawson does not disclose a pouch in which the sensor may be disposed. Therefore, Rawson does not anticipate or render obvious this Claim.

Claim Objections

The Examiner has objected to Claims 37-39, and 50 as depending from a rejected base claim. The Examiner has further indicated that Claims 37-39, and 50 would be allowable if the double patenting rejection was overcome and the claims were amended to include all limitations of the base claim and any intervening claim(s). Applicant has filed a terminal disclaimer. However, because Applicant believes the base claims are allowable, Applicant has not rewritten these claims. It is respectfully submitted that Claims 37-39, and 50 are in a condition for allowance.

The Examiner has objected to Claim 44 as depending from a rejected base claim. The Examiner has further indicated that Claim 44 would be allowable if amended to include all limitations of the base claim and any intervening claim(s). However, because Applicant believes the base claim is allowable, Applicant has not rewritten this claim. It is respectfully submitted that Claim 44 is in a condition for allowance.

The Examiner has indicated that Claim 46 would be allowable if the double patenting rejection was overcome. Applicant has filed a terminal disclaimer. It is respectfully submitted that Claim 46 is in a condition for allowance.

CONCLUSION

In view of the above, it is submitted that the remaining claims are in a condition for allowance. Reconsideration and withdrawal of the rejections and objections are hereby requested. Allowance of the pending claims at an early date is solicited.

If impediments to allowance of the pending claims remain, and a telephone conference between the undersigned and the examiner would help remove such impediments in the opinion of the examiner, a telephone conference is respectfully requested.

Respectfully submitted,

LOEFFLER JONAS & TUGGEY LLP
755 E. Mulberry Avenue, Suite 200
San Antonio, Texas 78212
(210) 354-4300 (telephone)
(210) 354-4034 (facsimile)

By: 

Cline H. White
Reg. No. 45,213

ATTORNEYS FOR APPLICANT

EXPRESS MAIL "Post Office to Addressee" Mailing
Label No.: EV307491523US
Date of Deposit: September 15 2004